

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID L. ROBINSON, JOHN F. WHALEN and JEFFERY T. BONK

Appeal No. 2005-0111
Application No. 09/518,120

HEARD: FEBRUARY 23, 2005



Before COHEN, NASE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 23-38, which are all of the claims pending in this application. Claims 1-22 have been canceled.

We REVERSE.

BACKGROUND

The appellants' invention relates to a linear seat recliner for use in a motor vehicle seat, a reclining seat assembly having such a recliner, a recliner rod for such a

seat recliner and a method of forming such a recliner rod. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Griswold et al. (Griswold)	5,299,853	Apr. 5, 1994
Dahlbacka	5,344,215	Sep. 6, 1994
Robinson	5,718,482	Feb. 17, 1998

The following rejections are before us for review.

Claims 23-28 and 32-38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dahlbacka in view of Robinson.

Claims 29-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dahlbacka in view of Robinson and Griswold.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed February 11, 2003) and answer (mailed January 27, 2004) for the examiner's complete reasoning in support of the rejections and to the brief (filed December 22, 2003) and reply brief (filed March 29, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner concedes that Dahlbacka's connecting rod 54, 154 (see Figures 4 and 11) comprises only two pairs of flats and thus lacks the at least three pairs of flats required in each of appellants' independent claims 23, 29, 32 and 36. Further, neither of Robinson and Griswold teaches or suggests a recliner rod having three pairs of flats. The examiner offers two alternate positions as to why the modification of Dahlbacka's rod shape to provide at least three pairs of flats would have been obvious to one of ordinary skill in the art at the time of appellants' invention. For the reasons which follow, neither of these positions is well taken.

The examiner's first position is that

the duplication of parts for a multiplied effect has no patentable significance, and it would have been well within the purview and obvious to one of ordinary skill in the art at the time the invention was made to provide another pair of parallel flats on the recliner rod such that the rod has a hexagonal cross section [final rejection, page 2-3].

We observe, at the outset, that the examiner's characterization of the change in cross-section of the rod simply as a duplication of parts for a multiplied effect lacks factual support in the record. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173,

178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, the examiner has not provided any evidence or explanation as to why one of ordinary skill in the art would have been motivated to make the change in cross-sectional shape proposed by the examiner to meet appellants' claims.

The examiner's alternate position, as articulated on page 4 of the answer, is that, in essence, the statements in appellants' specification, at page 6, lines 14-22, constitute an admission that "it is common knowledge to one of ordinary skill in the art to modify the recliner rod to have either two or three pairs of planar flats." The examiner goes on to dismiss the recliner rod shape having three pairs of flats as merely a matter of design choice (answer, page 4).

As for appellants' statements at page 6, lines 14-22, of the specification, appellants' teaching of alternate embodiments of cross-sectional shapes for the recliner rod in no way constitutes an admission that the provision of a recliner rod as claimed having either two or three pairs of flats was common knowledge to one of ordinary skill in the art at the time of appellants' invention. Moreover, the examiner's dismissal of the recliner rod shape as merely a design choice which does not serve to patentably distinguish the claimed invention over the prior art is inappropriate. It is elementary that

to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (see In re Royka, 490 F.2d 981, 984-85, 180 USPQ 580, 582-83 (CCPA 1974)) and that all words in a claim must be considered in judging the patentability of that claim against the prior art (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

For the foregoing reasons, we conclude that the combined teachings of the applied references Dahlbacka, Robinson and Griswold are insufficient to establish that the subject matter of appellants' claims would have been obvious to one of ordinary skill in the art at the time of the invention. We therefore cannot sustain the rejections of claims 23-28 and 32-38 as being unpatentable over Dahlbacka in view of Robinson or claims 29-31 as being unpatentable over Dahlbacka in view of Robinson and Griswold.

CONCLUSION

To summarize, the decision of the examiner to reject claims 23-38 under 35 U.S.C. § 103 is reversed.

REVERSED


IRWIN CHARLES COHEN
Administrative Patent Judge

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